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| 09/827,686 | 04/06/2001 | John Rizzotto | PAR-100US | 5077 |

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| EXAMINER |
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1731

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 040325

Application Number: 09/827,686
Filing Date: April 06, 2001
Appellant(s): RIZZOTTO ET AL.

James C. Simmons
For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 1700

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This is in response to the appeal brief filed January 14th, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 1731

| | | |
|-----------|-----------------|---------|
| 2,331,830 | Garber | 10-1943 |
| 3,067,068 | Finberg | 12-1962 |
| 3,702,615 | Rozacky et al. | 11-1972 |
| 5,368,873 | Aebi et al. | 11-1994 |
| 5,597,400 | Nonomura et al. | 01-1997 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8, 18, 24-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Finberg (US. Pat. No. 3,067,068).

Finberg discloses a chewing composition/tobacco substitute comprising cabbage leaves as a carrier, in combination with papaya leaves, both of which are heated such that, in the final product, the water content is between about 5 and about 14 percent by

Art Unit: 1731

weight (corresponding to the claimed "moisture content at or below 8% by weight"). The chewing composition may include humectants, such as glycerin; flavoring agents, such as apple cider (corresponding to the claimed "water soluble but not water containing flavoring ingredient... liquid form"); and other sweetening agents, such as vanillin.

Finberg teaches that the chewing composition can be produced in any conventional form, including shredded/strand form. (col. 5, line 52-col. 6, line 34; col. 7, line 68, col. 10, line 17-col. 12, line 17; see examples 1-4). While Finberg may not specifically state that the plant material has at least 30% intact cell walls, it is presumed that the cabbage leaves of its invention inherently possesses this characteristic since there is no requirement that, during the processing of the chewing product, the leaf composition be handled in a manner which would break the cellular structure of the vegetable material. In the alternative, the cell walls of Finberg would obviously be at least 30% intact due to the fact that that leaves comprising the chewing composition are merely mixed together, heated under pressure, and molded into a desired shape for subsequent shredding or the like. Further, it follows that the flavoring ingredients would be such that they would be capable of entering said cell walls since this must occur in order to appreciate the benefits of the ingredients in the final product. Lastly, since the preamble contains "comprising" language, the claims are open to include substances in addition to the edible cabbage carrier, flavoring ingredient and humectant combination. Therefore, even though the Finberg reference teaches a product with a combination of cabbage and papaya leaves, the disclosure still reads on the claims because the preamble does not recite "a chewable flavor delivery system consisting of in combination:...", even

Art Unit: 1731

though the claim recitation now requires a carrier "consisting of an edible... plant material being 100% cabbage leaves".

4. Claims 1, 4-6, 8, 18, 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aebi et al (US. Pat. No. 5,368,873).

Aebi discloses a vegetable composition which can comprise 100% cabbage leaves as a carrier, infused with humectant that can also include other sweeteners, such as a combination of fructose, and other sugars (corresponding to the claimed "water soluble...flavoring ingredient/sweetening agent") . In the final product, the water content is preferably from 2-6% by weight of water (corresponding to the claimed "moisture content at or below 8% by weight"). Aebi teaches that it is important to have the vegetable pieces, used in the product, of a size which facilitates infusion of the humectant, and that such size is preferably 1/16 – 3/16 inch in thickness. Example 8 discloses that the cabbage is sliced (corresponding to the claimed "strand"), and Example 10 discloses that the cabbage is ground such that it passes through a 20 mesh screen (corresponding to the claimed "pass a 16/20 mesh and be retained on a 30 mesh screen") (see entire reference). While Aebi may not specifically state that the plant material has at least 30% intact cell walls, it is presumed that the cabbage leaves of its invention inherently possesses this characteristic since it is clear that the disclosure teaches against damaging the leaf structure (see col. 9, line 67). In the alternative, the cell walls of Finberg would obviously be at least 30% intact due to the fact that that leaves comprising the vegetable composition are handled in such a way so

as to minimize structural damage. Further, it follows that the flavoring ingredients are capable of entering the intact cell walls since this obviously must occur in order to appreciate the benefits of said ingredients in the final product.

Claim Rejections - 35 USC § 103

5. Claims 4-6, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finberg (US. Pat. No. 3,067,068) in view of Garber (US. Pat. No. 2,331,830).

While Finberg may not specifically state that the cellulosic plant material of its invention is in a granular form, it does state that the chewing composition can be in any form that such compositions are conventionally provided (col. 5, lines 52-53). Further, Garber discloses chewing tobacco compositions that can be provided as granular particles (page 2, col. 2, lines 32-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the chewing composition of Finberg in the form of granules since this form of chewing tobacco is known in the art as evidenced by the Garber disclosure. While there may be no specific articulation of the claimed mesh sizes for the chewing composition of Finberg modified by Garber, it would have been obvious to one having ordinary skill in the art at the time of the invention to optimize the granule size and arrive at the claimed mesh sizes, after routine experimentation, in order to produce a chewing composition with granules having ideal surface area to effectively hold the conditioning agents. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

Art Unit: 1731

optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454,456, 105 USPQ 233,235 (CCPA)

6. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aebi (US. Pat. No. 5,368,873) in view of Nonomura et al (US. Pat. No. 5,597,400).

While the chewing composition of Aebi et al may not specifically state that the cabbage of its vegetable product is green cabbage, this limitation is not deemed to impart any patentable distinction to the claims because green cabbage classified as *Brassica oleracea capitata* is a commercially known plant/vegetable material, as evidenced by the Nonomura et al reference (col. 11, lines 8-9). Therefore, one having ordinary skill in the art would have been motivated to use it as the cabbage leaf vegetable material in the chewing composition of Aebi et al because of its market availability. Further, while Aebi modified by Nonomura et al may not disclose that the cabbage of its chewing composition is "freeze dried", since the claims are drawn to a product, patentability of the green cabbage claimed is based on differences in product characteristics, i.e. moisture content, not on its method of production. Absent evidence to the contrary, the Examiner presumes that the cabbage of Aebi et al modified by Nonomura et al is "characteristically" the same as the freeze-dried cabbage which is claimed.

7. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozacky et al (US. Pat. No. 3,702,615).

Rozacky et al discloses a non-tobacco, chewing product which can comprise 100% shredded cabbage carrier, humectant, fruit/plant extract (corresponding to the

Art Unit: 1731

claimed "sweetening agent"), and flavors (see entire reference). While Rozacky may not specifically disclose that the cabbage has a moisture content of at or below 8% by weight, it does state that the product can be dried to a suitable moisture content (see claim 1). Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to optimize the moisture content of the final product and arrive at the claims parameters, after routine experimentation, in order to produce an optimal non-tobacco composition. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454,456, 105 USPQ 233,235 (CCPA)

While Rozacky et al may not specifically state that the cabbage material has at least 30% intact cell walls, it is presumed that the cabbage leaves of its invention inherently possesses this characteristic since there is no requirement that, during the processing of the chewing product, the leaf composition be handled in a manner which would break the cellular structure of the vegetable material. In the alternative, the cell walls of Finberg would obviously be at least 30% intact due to the fact that that leaves comprising the chewing composition are merely mixed together, heated under pressure, and molded into a desired shape for subsequent shredding or the like. Further, it follows that the flavoring ingredients would be such that they would be capable of entering said cell walls since this must occur in order to appreciate the benefits of the ingredients in the final product.

Lastly, while Rozacky may not disclose that the humectant utilized in the product is glycerin or propylene glycol, or that the flavorant used is water soluble, but not water-

Art Unit: 1731

containing, (such as sucrose, fructose, etc) use of either of these types of flavorants/humectants would have been obvious to one having ordinary skill in the art since they are conventional choices for flavorants and humectants in the tobacco art.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rozacky et al (US. Pat. No. 3,702,615) in view of Nonomura et al (US. Pat. No. 5,597,400).

While the chewing composition of Rozacky et al may not specifically state that the cabbage of its vegetable product is green cabbage, this limitation is not deemed to impart any patentable distinction to the claims because green cabbage classified as *Brassica oleracea capitata* is a commercially known plant/vegetable material, as evidenced by the Nonomura et al reference (col. 11, lines 8-9). Therefore, one having ordinary skill in the art would have been motivated to use it as the cabbage leaf vegetable material in the chewing composition of Rozacky et al because of its market availability. Further, while Rozacky et al modified by Nonomura et al may not disclose that the cabbage of its chewing composition is "freeze dried", since the claims are drawn to a product, patentability of the green cabbage claimed is based on differences in product characteristics, i.e. moisture content, not on its method of production. Absent evidence to the contrary, the Examiner presumes that the cabbage of Rozacky et al modified by Nonomura et al is "characteristically" the same as the freeze-dried cabbage which is claimed.

(11) Response to Argument

- With respect to Appellant's arguments regarding the Finberg reference, and that its disclosure teaches a composition that must include papaya

Art Unit: 1731

leaves, in addition to cabbage, the Examiner does not disagree that the Finberg reference requires both papaya leaves and cabbage leaves in its final product; *however*, the Examiner contends that the claims, as presently stated, are open to the inclusion of material, in addition to the 100% cabbage carrier, humectant and flavoring combination because of the "comprising" language in the preamble. Therefore, the Finberg reference can be properly applied to the claims since the Examiner believes that the reference discloses a product which may comprise a carrier consisting of 100% cabbage leaves in addition to a carrier that consists of 100% papaya leaves.

- Appellant argues that the Finberg reference teaches flavoring of cabbage leaves prior to grinding, which contrasts with Applicant's invention which teaches grinding before flavoring; *however*, Appellant has not claimed any particular order of flavoring/grinding. These claims are drawn to a product, not a method. Therefore, any method step differences, i.e. grinding then flavoring, would not patentably distinguish the claims from the reference since this limitation does not "characteristically" or "structurally" distinguish the claims from the reference.
- Appellant argues that Finberg does not teach drying the initial product to a moisture content of 8%, but is concerned that the final moisture content may rise to at least 14% by weight. *However*, the Examiner

disagrees. Clearly, stated in col. 11, lines 33-43, Finberg discloses that the last heating step, in the production of the product, is designed to provide a product having a moisture content of anywhere between 5-14%. This range would include the 8% moisture content which is claimed.

- Appellant argues that Finberg does not teach the form in which the papaya leaves must be used; however, the Examiner points out that the Finberg reference indicates that the final product (which would include both papaya leaves and cabbage leaves) can be in any conventional form. Further, throughout the reference, Finberg states that the product, in the form of a tobacco chew substitute, may be shredded – into varying sizes (see col. 11, lines 42-43) And, the Garber reference is introduced merely to teach that typical forms for chewing products, in the tobacco area, are either strands, shreds or granules.
- Appellant asserts that Aebi et al discloses preserving vegetables such as bell peppers and onions, but not cabbage. However, the Examiner disagrees. Aebi et al states, at least in col. 3, line 11; col. 6, line 23, and in Examples 8 and 10, that cabbage is among the many vegetables which can be treated in accordance with the disclosed process/invention.
- Appellant also argues that there is no teaching, in the Aebi et al reference, of the size of cabbage leaves in the Example 8; however, the Examiner points out that in col. 15, line 36, it states that the cabbage is

Art Unit: 1731

sliced into one-eighth inch slices – which can be equated to the claimed “shreds”. Also, in Example 10, Appellants have challenged the Examiner to substantiate the fact that Aebi et al shows cabbage ground so that it passes through a 20 mesh screen. So, the Examiner wishes to point out that, in col. 17, line 50, it states that the cabbage was ground with a coffee mill so that is passed through a 20 mesh screen (after first having been cut into one-eighth inch slices).

- Appellant argues that the Nonomura et al reference fails to teach freeze dried cabbage classified as brassica oleracea. The Examiner acknowledges that she has not utilized the Nonomura et al reference as one that anticipates the claims in question, but merely has used such reference to teach that the type of broccoli known as “brassica oleracea” a commercially available and, therefore, known vegetable product that one having ordinary skill in the art would have used as the vegetable product of Aebi et al/Rozacky et al. And, as stated in the rejection, the “freeze-dried” limitations appear to suggest the manner in which the cabbage is prepared. The fact that the product of Aebi et al/Rozacky et al modified by Nonomura et al would have the claimed moisture content is sufficient, the Examiner believes, to satisfy this limitation of the claims.
- Appellant argues that the Rozacky et al reference neither teaches nor suggests any specific plant or tree leaf material to be used in their process. However, the Examiner brings to Appellant’s attention col. 1,

line 42, which states that the invention of Rozacky et al can be applied to many types of non-toxic plants/vegetables, such as cabbage.

- Appellant argues that the Rozacky et al reference does not specifically teach or suggest that cabbage leaves can be used to produce a chewable flavor delivery system or an oral tobacco substitute, but, the Examiner wishes to point out that what is disclosed in Rozacky et al is a non-tobacco smokable, chewing or dipping product. The Examiner believes that this corresponds to the claimed "chewable flavor delivery system" or "oral tobacco substitute", if for no other reason, because the structural nature/characteristics of the claimed product and that disclosed in the Rozacky et al reference is almost the same.
- Appellant argues that Rozacky's product must have a higher moisture content than that which claimed. The Examiner contends that one having ordinary skill in the art would have arrived at the claimed moisture amount in an effort to optimize the moisture content of the final product. Col. 2, lines 10-47 of Rozacky et al describes the process of preparing the tobacco substitute, and includes drying the product to 10% (see line 30), and then subjecting the product to subsequent drying (lines 44-45). The Examiner believes that it is reasonable to expect that subsequently drying a product having 10% moisture content would result in arriving at the claimed moisture content, which is below 8%, in an effort to find the "suitable" moisture content as taught in the Rozacky reference.

Art Unit: 1731

- Lastly, Appellant argues that there is no teaching in the prior art of record, or any basis for the conclusion that the references suggest cabbage leaves having at least 30% intact cell walls. However, the Examiner has indicated that based on the wording of each of the references regarding the intent to preserve the natural leaf structure of the plant, and the disclosure of preparation of the product in such a way that does not involve grinding or pulverizing the leaves, this is an indication that the products disclosed in the references inherently or, in the alternative, obviously possess the "30% intact cell walls" characteristic. With this statement, in the Final Rejection, the Examiner has met her burden by pointing out why it is believed that one would reasonably expect that at least 30% of the cellular walls would remain intact. Appellant has merely argued its position to the contrary, but has not met its burden to show or present evidence that such characteristic is not reasonable to expect in the product of the references of record.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/827,686

Page 15

Art Unit: 1731

Respectfully submitted,

Dionne A. Walls
Primary Examiner
Art Unit 1731

A handwritten signature in black ink, appearing to read 'DAW' with a stylized flourish above the letters.

DAW

March 27, 2004

Conferees

Steven Griffin

A handwritten signature in black ink, appearing to read 'SG' with a stylized flourish.

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